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EXAMINER

STIMPAK, JOHNNA

| ART UNIT | PAPER NUMBER |
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3623

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/038,881

Applicant(s)

KALISH ET AL.

Examiner

Johnna R Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-34 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-34 and 37-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following is a final office action upon examination of application number 10/038,881. Claims 1-13, 15-34 and 37-48 are pending and have been examined on the merits discussed below.

#### ***Response to Arguments***

2. Applicant's arguments filed August 5, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument, regarding claims 3, 4, 24 and 25, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). As claimed, a higher degree of publicity than is average for the businesses is purely subjective. It is not specified in the claims what this average is based on and what would constitute a higher degree of publicity. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments regarding the rejections of claims 1-13, 15-34 and 37-48 under 35 USC 103(a), that a mix of human and machine decision making is not taught by the combination of Themescape and Karszes, examiner respectfully disagrees. Themescape uses "machine decision making" in culling through the business opportunities and using an elimination tool which organizes the data into a map showing where there is a high concentration of documents about the opportunity. Karszes teaches "human decision making" wherein one determines if an investment is worth it. In the previous rejections, repeated below, the

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combination of Themescape and Karszes provides a teaching of a mix of human and machine decision making to arrive at a decision.

As for the argument that the combination will reflect bias of the individual making the decision, applicant is arguing features that are not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Applicant's arguments, see page 9, filed August 5, 2004, with respect to rejections under 35 USC 112, second paragraph of claims 1, 7, 8, 28 and 29 have been fully considered and are persuasive. The 112, 2<sup>nd</sup> rejections of claims 1, 7, 8, 28 and 29 have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As claimed, a higher degree of publicity than is average for the businesses is purely subjective. It is not specified in the claims what this average is based on and what constitutes a higher degree of publicity.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-13, 15-20, 22-34, 37-41 and 43-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Themescape in view of Karszes.

As per **claim 1 (currently amended)**, Themescape teaches identifying a first set of potential business opportunities of interest to a business from an initial, larger pool of business opportunities (page 1, the user searches for the topic of interest contained within large numbers of documents); analyzing the first set of business opportunities by having a group of persons evaluate them using an elimination tool which generates a set of data, the data providing for a ranking of the business opportunities in the first set (page 1, the data is organized into a map showing peaks where there is a high concentration of documents about the opportunity showing which topics dominate the document collection); culling from the first set of business opportunities a reduced second set of business opportunities having a ranking above a predetermined level (page 1, the high concentration of documents about an opportunity inherently shows a high ranking of popularity of an opportunity, i.e., there are numerous documents containing information about that opportunity) and providing a graphical representation of the first and second characteristics for at least some of the business opportunities in the second set (page 1, the results are presented in a map form). While Themescape does not explicitly teach analyzing the business opportunities once ranked, Karszes

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et al teach analyzing a business opportunity to determine if an investment into the new technology or opportunity would be feasible based on several considerations. Specifically Karszes et al teaches determining a characteristic that provides a measure of its usability and a characteristic that provides a measure of its appropriability for each of them (page 1, point 2, does it support your goals and interest (usability) and does the adoption support your business and help it move toward its goal (appropriability)). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user would need a tool to narrow their choice even more. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

Neither Themescape nor Karszes teach a computerized evaluation using numerical ratings. Although this combination does not explicitly teach the process of evaluating a business opportunity taking place over a computerized system, official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the user can enter a numerical ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the survey of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 2**, Themescape teaches the initial, larger pool of business opportunities is identified by examining publications of interest (page 1).

As per **claim 3**, Themescape teaches the first set of potential business opportunities is characterized by a disproportionate amount of recent publicity (page 1, the map in Themescape represents a high concentration of documents about a business opportunity with peaks).

As per **claim 4**, Themescape teaches the first set of potential business opportunities is characterized by little publicity prior to a selected date (page 1, peaks with large distance in between show there is less publicity about a topic).

As per **claim 5**, Themescape teaches web pages are searched for business opportunities (page 1, Themescape 2.0 searches mass amounts of documents on the web).

As per **claim 6**, Themescape does not explicitly teach the elimination tool comprises a set of criteria for judging the first set of business opportunities. However, Karszes et al teaches the elimination tool comprises a set of criteria for judging the first set of business opportunities (page 1, a set of survey questions are presented to evaluate the business opportunities).

Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user would need a tool to narrow their choice even more. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

As per **claim 7 (currently amended)**, Themescape does not explicitly teach the criteria include providing a numerical valuation of the uniqueness of the opportunity. Karszes teaches evaluating if research supports the new technology and verifies claims about its impact (page 1). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user would need a tool to narrow their choice even more.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

As per **claim 8 (currently amended)**, Themescape does not explicitly teach the criteria include providing a numerical valuation of the advantages of the opportunity over other business opportunities. Karszes teaches the criteria include an evaluation of the how the business opportunity can help it move toward its goals (page 1). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user can narrow the choice with Karszes evaluation criteria. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions about advantages of the opportunity with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

As per **claim 9**, Themescape does not explicitly teach evaluation of the business opportunities by each person. Karszes teaches each of the business opportunities is evaluated by each of the persons interested in the opportunity (page 1, if the user wants to know if the opportunity is worth their while they follow the survey questions). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user can narrow the choice with Karszes evaluation criteria. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions about the opportunity with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.



As per **claim 10**, the combination of Themescape and Karszes does not explicitly teach each person provides a score for each of the criteria for every business that the persona evaluates. However, as recited in the rejection of claim 1 above, official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the user can enter the ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 11**, the combination of Themescape and Karszes does not explicitly teach the elimination tool provides a statistical summary of the numerical ranking. However, as recited in the rejection of claim 1 above, it is old and well known to present survey questions in a Microsoft Excel format wherein the user can enter the ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 12**, Themescape teaches a computer is used to collect and analyze the data generated by use of the elimination tool (page 1, Themescape is implemented on a computer).

As per **claim 13**, the combination of Themescape and Karszes does not explicitly teach a computer is used to determine the first and second characteristics. However, as recited in the rejection of claim 1 above, official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the characteristics being evaluated can be

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determined and the user can enter a numerical ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 15**, Themescape does not explicitly teach the numerical characteristic is a measure of the ease with which the opportunity can be acquired. Karszes teaches a question directed to measuring if your current business has what is necessary to take advantage of the new opportunity (page 2, top of page). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user can narrow the choice with Karszes evaluation criteria. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ Karszes survey questions about acquiring the opportunity with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

As per **claim 16**, Themescape does not explicitly teach the numerical characteristics are determined by evaluating a business opportunity according to sets of criteria. Karszes teaches evaluating business opportunities with survey questions directed to advantages, usability and appropriability (page 1, questions directed to if the opportunity supports goals and interests, if the adoption of the opportunity will help you move toward your goal, etc.). Themescape, on it's own, only narrows the mass amounts of publicity, but once the most popular business opportunities are identified, a user can narrow the choice with Karszes evaluation criteria. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ

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Karszes survey questions about acquiring the opportunity with Themescapes search tool. This would offer the user an efficient way to ultimately choose a business opportunity.

Neither Themescape nor Karszes teach using numerical evaluation. However, official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the characteristics being evaluated can be determined and the user can enter a numerical ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 17**, the combination of Themescape and Karszes does not explicitly teach a single person determines numerical rankings for the criteria. Karszes does teach a survey to evaluate the criteria. As recited in the rejection for claims 1 and 16 above official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the characteristics being evaluated can be determined and the user can enter a numerical ranking of the importance in the appropriate cell. Therefore it would have been obvious one of ordinary skill in the art to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 18**, the combination of Themescape and Karszes does not explicitly teach the numerical values of the first and second characteristics determine whether the business opportunity is one that should be pursued by an approach selected from the group consisting of adoption, partnering and investing. The ultimate goal the Themescape/Karszes combination is to

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determine whether a business opportunity is worthwhile (is it worth adopting or investing in). Official notice is taken that it is old and well known in the art to implement a survey such as Karszes' in a Microsoft Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc. Since the ultimate goal of Karszes is to evaluate criteria to decide if a business opportunity is worthwhile, i.e. is it worth adopting or investing in by implementing Karszes in excel, the numerical values would be evaluated to determine if the business opportunity should be pursued.

As per **claim 19**, the combination of Themescape and Karszes does not explicitly teach the numerical values of the characteristics are plotted on a graph. However, as stated in the rejection of claim 1, official notice is taken that it is old and well known to present survey questions in a Microsoft Excel format wherein the characteristics being evaluated can be determined and the user can enter a numerical ranking of the importance in the appropriate cell. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claim 20**, the combination of Themescape and Karszes does not explicitly teach the graph is in a form of a matrix. However, official notice is taken that it is old and well known to present survey questions in Microsoft Excel format wherein the characteristics being evaluated can be determined and the user can enter a numerical ranking of the importance in the appropriate cell. Using all the known benefits of Excel the user could then analyze the results in such ways as statistics or graphs of all types. Therefore it would have been obvious to

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implement the evaluation method of Karszes in an Excel format. The benefit would be to present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

As per **claims 22-34 and 37-41**, they are directed to the same method as claims 1-13 and 15-20. The only difference is in the preamble where claims 1-16 and 18-20 are directed to evaluating business opportunities and claims 22-37 and 39-41 are directed to evaluating technologies. Since new technology can be considered as a new business opportunity, the same rejection as applied to claims 1-16 and 18-20 is applied to claims 22-37 and 39-41.

As per **claim 43**, it is the apparatus with means to perform the method of claim 1, therefore the same rejection as applied to claim 1 also applies to claim 43.

As per **claim 44**, Themescape teaches the means for identifying a first set of potential technologies comprises a computer (page 1, Themescape is a computerized tool for scanning large numbers of documents).

As per **claim 45**, Themescape does not explicitly teach the means for analyzing the technologies comprises a set of numerically gradable criteria provided to the persons. Karszes teaches a set of questions to determine if the opportunity is worthwhile. Numerous methods can be employed to evaluate the questions. Official notice is taken that it is old in well known in the art of surveys to numerically rank or grade criteria to determine those criteria with more importance or relevance. Therefore it would have been obvious to one of ordinary skill in the art to combine Themescapes search tool with Karszes survey to rank or grade the criteria of most importance to the business. The implementation would allow the user to quickly determine if a business opportunity is worth looking into.

As per **claim 46**, Themescape teaches the means for culling from the first set of technologies a reduced second set of technologies comprises a computer (page 1, Themescape is a computer implemented method of culling through large amounts of documents to arrive at a smaller number of documents about the technologies).

As per **claim 47**, Themescape does not teach analyzing the second set of technologies. Karszes teaches analyzing the second set of technologies comprises human judgment (page 1, the survey is completed using human judgment). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Themescape with Karszes method to produce a user-friendly system to evaluate business opportunities. The combination of Themescape and Karszes does not teach evaluating the second set of technologies comprises machine calculation. However, official notice is taken that it is old and well known to implement a survey in Microsoft Excel format where in all the benefits of Excel can be used such as calculations and graphing. Therefore it would have been obvious to one of ordinary skill in the art to implement the Karszes survey in Excel for a user-friendly format wherein the characteristics can be ranked for choosing a business opportunity.

As per **claim 48**, the combination of Themescape and Karszes does not explicitly teach the graph is in a form of a matrix. However, official notice is taken that it is old and well known to present survey questions in Microsoft Excel format wherein the characteristics being evaluated can be determined and the user can enter a numerical ranking of the importance in the appropriate cell. Using all the known benefits of Excel the user could then analyze the results in such ways as statistics or graphs of all types. Therefore it would have been obvious to implement the evaluation method of Karszes in an Excel format. The benefit would be to

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present a user-friendly format wherein the user could enter ranking information and use all the benefits of Excel for compiling results, graphing, etc.

7. **Claims 21 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Themescapes and Karszes.

The combination of the references teaches representing a data in a graphical format. The references do not disclose expressly a representation of the data in a matrix comprising nine rectangles.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to divide the graphical matrix into nine rectangles which are labeled by at least one of the words adopt, partner, invest, and ignore because applicant has not disclosed that dividing the matrix into nine rectangles solves any stated problem, is used for a particular purpose nor provides any advantage. Further, the combination of Themescape and Karszes (implemented in an Excel format) would have been expected by those of ordinary skill in the art to perform equally well with either a nine rectangle matrix or any other graph because it is simply a visual way to show which business opportunity is best to follow through with.

Therefore, it would have been an obvious matter of design choice to modify the combination of Themescapes and Karszes (implemented in an Excel format) to obtain the invention as specified in claims 21 and 42.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R Stimpak whose telephone number is 703-305-4566. The examiner can normally be reached on M-F 8am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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JS

1/7/05



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